

Attorney Docket No. P69451US1
Application No. 10/586,329

Remarks/Arguments:

Claims 1-31 are pending.

Claims 20-31 are amendment, hereby, to more clearly define the instant invention, as further explained below, in the remarks addressing the rejection under 35 USC § 112, ¶ 2.

Claims 20-31 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Reconsideration is requested.

The rejected claims were found indefinite for reciting the "Use of" but, allegedly not reciting "any steps involved in the method/process" (Office Action, page 2). With all due respect, the finding is incorrect.

Each of the rejected claims contains subject matter that further limits the claim on which it is dependent; and, as such, each is a proper, dependent claim (35 USC 112, paragraph 4) implicitly satisfying the requirements of § 112, ¶ 2.

Merely that the rejected claims happen to recite the words use of does not render them indefinite under § 112, ¶ 2. For example, rejected claim 20 recites use of "a voltage-sensitive or ion-sensitive indicator for the conductance of the method according to claim 1." As described in the subject application (page 5, last paragraph), the "value of the measuring parameters"—to which claim 1 is limited—can involve examining "the activity of a voltage-sensitive ion channel." Thus, the meaning of allegedly indefinite claim 20 becomes readily apparent with reference to the instant specification and, so, the claim is not indefinite. While *limitations* from the specification cannot be read into the claims, words in the specification are properly used during prosecution as an aid in

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interpret existing claim limitations. The PTO has been cautioned not to confuse the former with the later:

The Commissioner confuses [1] impermissibly imputing limitations from the specification with [2] properly referring to the specification to determine the meaning of a particular word or phrase recited in a claim.

In re Donaldson Co. Inc., 29 USPQ2d 1845, 1850 (Fed. Cir. 1994). "A claim is not 'indefinite' simply because it is hard to understand when viewed without benefit of the specification." *S3 Inc. v. nVIDIA Corp.*, 59 USPQ2d 1745, 1748 (Fed. Cir. 2001).

Notwithstanding the foregoing, in order to advance prosecution, applicants have amended the rejected claims in order to more clearly define the invention. The rejected claims (as amended) now recite "A method of using." Additionally, the rejected claims (as amended) now recite more active method language, i.e., by changing "for the conductance of" to "in conducting."

In view of the foregoing remarks, the rejection of claims 20-31 under §112, ¶2, is overcome. Withdrawal of the rejection appears to be in order.

It should also be pointed out that the rejected (and present) claims 20-31 were implicitly found allowable, in accordance with the instant office action, since the claims were not rejected over the prior art. MPEP 2143.03 ("All words in a claim must be considered in judging the patentability of that claim against the prior art [citation omitted]").

Claims 1-19 were rejected under 35 USC 103(a) as allegedly unpatentable over *Biochimica et Biophysica Acta*, 728, 305-310, 1983 (Siem-Fung) in view of *DDT*, 6, 78-84, 2001 (Netzer) and *TCM*, 11, 54-59, 2001 (Neumann). Reconsideration is requested.

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To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art," *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

The rejected claims are limited to

determining a value of a measuring parameter . . . performed at a temperature of about 10 °C.

None of the cited references, taken alone or in combination, teaches or suggests the step/limitation of determining the value of a measuring parameter "performed at a temperature of about 10°C," which fact is not contested by the PTO. Since "the cited references do not support each limitation of [the] claim[s]," the rejected for alleged obviousness is "inadequate on its face." *Thrift*, 63 USPQ2d at 2008. Since all of the claim limitations are not taught or suggested by the cited prior art, a *prima facie* case of obviousness has not been established by the PTO. *Royka, supra*.

Applicants realize that, in order to meet the aforesaid claim limitation, which is neither taught nor suggested in any of the cited references, the PTO alleges (Office Action, page 4):

The result-effective adjustment of particular conventional working conditions (e.g., using a particular method of measuring ion channel activity and/or membrane

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potential) is deemed merely a matter of judicious selection and routine optimization which is well within the preview of the skilled artisan.

With all due respect, the reliance is misplaced, since it is legally erroneous.

The PTO reliance on what is "deemed"—instead of what is taught or suggested by the prior art—renders the rejection untenable.

The examiner should be aware that "deeming" does not discharge him from the burden of providing the requisite factual basis and establishing the requisite motivation to support the conclusion of obviousness. . . . The examiner's reference to unidentified phantom prior art techniques . . . falls short of the mark.

Ex parte Stern, 13 USPQ2d 1379, 1382 (BPA&I 1989). "It is facts which must support the legal conclusion of obviousness." *Ex parte Crissy*, 201 USPQ 689, 695 (POBdApp 1976).

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because *it may doubt* that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

In re Warner, 154 USPQ 173, 178 (CCPA 1967) (*emphasis original*). An argument by the USPTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *In re Ochiai*, 37 USPQ2d 1127, 1129 (Fed. Cir. 1995) ("Reliance on *per se* rules of obviousness is legally incorrect and must cease").

Similarly, the PTO reliance on alleged "routine optimization"—to make up for the missing claim limitation—renders the rejection untenable.

Where the *optimization* of a claim variable was not recognized in the art as effecting the claimed result, the result is unobvious. *In re Antonie*, 195 USPQ 6, 8 (CCPA 1977). That a

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difference with the prior art amounts to an alleged "optimal condition . . . is not a substitute for some teaching or suggestion supporting an obviousness rejection." *Rijckaert*, 28 USPQ2d at 1957.

Similarly, also, PTO reliance on what is allegedly "well within the perview of the skilled artisan" renders the rejection untenable. "That which is within the capabilities of one skilled in the art is not synonymous with obviousness [citations omitted]." *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993).

the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at . . . [the claimed] invention because he had the necessary skills to carry out the requisite process steps This is an inappropriate standard for obviousness.

Levengood, 28 USPQ2d at 1301.

Applicants, also, wish to point out that the presently claimed invention minimizes the risk that a potential value measured is biased due to counter-regulation mechanisms. As taught in the subject application (paragraph bridging pages 2 and 3),

if one monitors the membrane potential of living cells under the influence of a potential or known pharmacologically active substance in a test method, there is a risk that the potential value measured is biased due to the counter-regulation mechanisms described. This biasing can even be so high that an affection of the membrane potential may not be recognizable when the signal-to-noise ratio is unfavorably high.

Thus, it is the object of the present invention to provide a test method for examining the activity of ion channels which minimizes the above mentioned interferences.

Both the problem (i.e., risk that a potential value measured is biased due to counter-regulation mechanisms) and its solution (i.e., minimizing the risk by the presently claimed method) are neither

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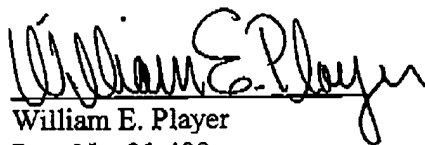
taught nor suggested by the cited references, which demonstrates patentability of the rejected claims.

In re Spinnoble, 160 USPQ 237, 243 (CCPA 1969) (a "patentable invention may be in the discovery of the source of the problem").

In view of the foregoing remarks, the rejection of claims 1-19 under §103(a), based on the combined teachings of Siem-Fung, Netzer, and Numann, is overcome. Withdrawal of the rejection appears to be in order.

Favorable action is requested.

Respectfully submitted,



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